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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/600,926 | 06/19/2003 | Leo Shih | OR0311 | 6217 |
| 22192 | 7590 | 03/16/2005 | EXAMINER | |
| LAW OFFICE OF LIAUH & ASSOC. 4224 WAIALAE AVE STE 5-388 HONOLULU, HI 96816 | | | FIDEI, DAVID | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3728 | |

DATE MAILED: 03/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/600,926 | SHIH, LEO el | |
| | Examiner | Art Unit | |
| | David T. Fidei | 3728 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Claim Construction

1. In analyzing applicant's invention as set out in the pending claims, the examiner sets forth the following to aid in understanding the application of the prior art herein. Claims are to be given their broadest reasonable interpretation during prosecution, see *In re Priest*, 582 F.2d 33, 37 199 USPQ 11, 15 (CCPA 1978), and limitations from the specification will not be read into the claims, see, e.g. *In re Prater*, 415 F.2d 1393, 1404-1405, 162 USPQ 541, 550-51 (CCPA 1969), see § MPEP 2106.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Pemberton (Patent no. 4,688,672). In figure 1 a tool organizer is disclosed comprising a base 10 and a plurality of retaining members 12 on the base for retaining removable the tools. The retaining members are formed of a retaining portion 14 and a specification mark 32 located along (as in with) the retaining portion to denote the specification of a working end of a tool, whereby the retaining portion is used to removably retain the working end of each tool.

4. Claim 1, 2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Blacker (Patent no. 5,743,395). In figure 1 a tool organizer is disclosed comprising a base 2 and a plurality of retaining members 3-12 on the base for retaining removable the tools. The retaining members are formed of a retaining portion 3-12 and a specification mark located along the retaining portion (lengthwise) to denote the specification of a working end of a tool, whereby the retaining portion is used to removably retain the working end of each tool.

As to claim 2, Blacker discloses an organizer used to arrange orderly a series of sockets of a socket wrench, said organizer comprising a base 2 and a plurality of retaining members 3-12 mounted at intervals on said base for retaining removably the sockets, each having a working end with a hexagonal slot of a specification; wherein said retaining members are formed of a retaining portion and a specification mark (denoted by the size markings along members 3-12) located along with said retaining portion to denote the specification of the hexagonal slot of the working end of the socket whereby said retaining portion is of a hexagonal construction and is corresponding in specification to the hexagonal slot of the working end of the socket, with said retaining portion being removable fitted into said hexagonal slot of the working end of the socket.

As to claim 4, an elastic piece, such as plastic, col.3, line 13 is contemplated.

5. Claim 1, 2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by DeLucchi (Patent no. 4,621,738). See col. 2, lines 17-20, figures 1 and 2.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brennan (Patent no. 4,997,085) in view of Backer (Patent no. 5,743,395). Brennan discloses an organizer used to arrange orderly a series of sockets of a socket wrench, said organizer comprising a base 10 and a plurality of retaining members 30 mounted at intervals on said base for removably retaining the a working end of a specification a socket, with said retaining portion being

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removable fitted into the working end of the socket. The difference between the claims 1, 2 and the subject matter of Brennan resides in a specification mark located along with the retaining portion.

Backer teaches a specification mark located along with a retaining members 3-12 as is well known to those skilled in the art. It would have been obvious to one of ordinary skill in the art to modify Brennan by providing a specification mark as taught by Backer, in order to provide a means of identifying the correct tool with the appropriate retainer.

As to claim 3, the retaining portion 30 is of circular construction.

8. Claims 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sandrick (Patent no. 3,337,058) in view of Thomson (Patent Pub. no. US 2004/0079661 A1). Sandrick disclose a screwdriver organizer H & S, to arrange orderly a series of screwdrivers 10, 10a. The organizer comprising a base S and a plurality of retaining members 30, 32 mounted at intervals on the base S for retaining removably the screwdrivers whereby the working end of the screwdriver is retained. The difference between the claimed subject matter and Sandrick resides in a specification mark located along with the retaining portion of the apertures defined by retaining members 30, 32.

Thomson teaches a tool holder 34 for bits 36 along with markings provided along the outside of the holders 34 to identify which bits should be placed in the respective holders, see paragraph [0024]. It would have been obvious to one of ordinary skill in the art to modify the organizer of Sandrick by constructing specification mark located along with the retaining portion of the retaining members as suggested by Thomson, in order to provide a means of identifying the tool for fast access to a particular tool.

REPLY BY APPLICANT OR PATENT OWNER TO THIS OFFICE ACTION

9. "In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to every ground of objection and rejection in this Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including

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any newly presented claims, patentable over any applied references. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. The reply must be reduced to writing (emphasis added)", see 37 CFR 1.111 (b) & (c), M.P.E.P. 714.02.

Pointing out specific distinctions means clearly indicating in the written response what features/elements or distinctions have been added to the claim/claims, where support is found in the specification for such recitations and how these features are not shown, taught, obvious or inherent in the prior art.

If no amendments are made to claims as applicant or patent owner believes the claims are patentable without further modification, the reply must distinctly and specifically point out the supposed errors in the examiner's action and must respond to every ground of objection and rejection in the prior Office Action in the same vain as given above, 37 CFR 1.111 (b) & (c), M.P.E.P. 714.02.


The examiner also points out, due to the change in practice as affecting final rejections, older decisions on questions of prematurity of final rejection or admission of subsequent amendments do not necessarily reflect present practice. "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)" (emphasis mine), see MPEP 706.07(a).

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Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fidei whose telephone number is (571) 272-4553. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David T. Fidei
Primary Examiner
Art Unit 3728

dtf
March 15, 2005